

Appln. No. 10/657,044  
Amendment dated July 14, 2005  
Reply to Office Action mailed December 23, 2004

### REMARKS

Reconsideration is respectfully requested.

Claims 1 through 7 and 9 through 13 remain in this application. Claim 8 have been cancelled.

The Examiner's rejections will be considered in the order of their occurrence in the Office Action.

### Sections 1 and 2 of the Office Action

Claims 1, 2, 4, 5, 8, 10 and 11 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Bader (5,817,041) in view of Padilla (4,641,639).

In regard to claim 1, it is submitted that the combination of Bader with Padilla is not suggested by the prior art, and even if such a combination were to be made, one would not be led to the combination of features recited in applicants' claims. In particular, the references do not disclose, teach or suggest "each support member having an extension portion and a foot portion, said extension portion extending from said foot portion at an angle such that said extension portion is adapted for positioning in front of a lateral malleolus of the user, said foot portion of each of said support members being positioned in a spaced relationship and below the foot of the user to inhibit the foot of the user from contacting the supporting surface, said foot portion of each of said support members being positioned to a respective side of the foot without extending under the foot of the user to allow the foot portion of each of said support members to contact the support surface without said foot portion of said support members contacting the foot for inhibiting transfer of pressure into the foot of the user". The Bader reference teaches a rigid lower-limb orthotic that fails to teach each of the foot portions being positioned to respective sides of the foot while not extending under the foot to inhibit transfer of force to the foot of the user when the foot portions contact the supporting

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surface as claimed by the applicant. Further, the Bader reference teaches away from that claimed by the applicant in that the Bader reference teaches the orthotic that supports the foot and abuts the bottom of the foot and therefore when the user walks some force is transferred into the foot through the contact of the orthotic with the bottom of the foot when the user stands or walks on that foot. The Padilla reference teaches an ambulatory brace assembly that fails to teach each of the foot portions being positioned to respective sides of the foot while not extending under the foot to inhibit transfer of force to the foot of the user when the foot portions contact the supporting surface as claimed by the applicant. Further, the Padilla reference teaches away from that claimed by the applicant in that the Padilla reference teaches the cast portion of the brace assembly contacting the bottom of the foot of the user with the legs of the brace assembly extending downwardly and below the foot of the user thereby allow force to be applied to the bottom of the foot of the user and cast is pulled upwards by the user putting weight on the legs of the brace assembly. It is also submitted that the mere fact that one may argue that the prior art is capable of being modified to achieve a claimed structure does not by itself make the claimed structure obvious--there must be a motivation provided by the prior art, and that motivation is totally lacking in the reference.

The examiner finds the claimed shape would have been obvious urging that (our emphasis) "it is obvious for one skilled in the art to form each hook base of any desired shape \*\*\* since *this is within the capabilities of such a person.*" Thus, the examiner equates that which is within the capabilities of one skilled in the art with obviousness. Such is not the law. There is nothing in the statutes or the case law which makes "that which is within the capabilities of one skilled in the art" synonymous with obviousness.

The examiner provides no reason why, absent the instant disclosure, one of ordinary skill in the art would be motivated to change the shape of the coil hooks of Hancock or the German patent and we can conceive of no reason.

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Ex parte Gerlach and Woerner, 212 USPQ 471 (PTO Bd. App. 1980)  
(emphasis in original).

Therefore, it is submitted that the combination of the Bader reference with the Padilla reference would not lead one to the combination of features as claimed by the applicant.

Claims 2, 4, 5, 8, 10 and 11 are dependent upon claim 1, particularly as amended, and therefore incorporate the requirements of claim 1. Thus, claims 2, 4, 5, 8, 10 and 11 are also believed to be allowable over the cited reference.

Withdrawal of the §103(a) rejection of claims 1, 2, 4, 5, 8, 10 and 11 is therefore respectfully requested.

### Section 3 of the Office Action

Claims 3, 6, 7 and 9 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Bader (5,817,041) in view of Padilla (4,641,639) and in view of Sichau (3,805,773).

In regard to claim 1, it is submitted that the combination of Bader with Padilla and Sichau is not suggested by the prior art, and even if such a combination were to be made, one would not be led to the combination of features recited in applicants' claims. In particular, the references do not disclose, teach or suggest "each support member having an extension portion and a foot portion, said extension portion extending from said foot portion at an angle such that said extension portion is adapted for positioning in front of a lateral malleolus of the user, said foot portion of each of said support members being positioned in a spaced relationship and below the foot of the user to inhibit the foot of the user from contacting the supporting surface, said foot portion of each of said support members being positioned to a respective side of the foot without extending under the foot of the user to allow the foot portion of each of said support members to contact the support surface without said foot portion of said support members contacting the foot for inhibiting transfer of pressure into the

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foot of the user". As discussed above, the Bader and Padilla references teach away from each of the foot portions being positioned to respective sides of the foot while not extending under the foot to inhibit transfer of force to the foot of the user when the foot portions contact the supporting surface as claimed by the applicant. The Sichau reference teaches a training assist brace that fails to teach each of the foot portions being positioned to respective sides of the foot while not extending under the foot to inhibit transfer of force to the foot of the user when the foot portions contact the supporting surface as claimed by the applicant. Further, the Sichau reference teaches away from that claimed by the applicant in that the Sichau reference teaches the insole contact the bottom of the foot and contacting the floor and thereby allows a portion of the force to be transferred to the foot of the user when the user is standing or walking. It is also submitted that the mere fact that one may argue that the prior art is capable of being modified to achieve a claimed structure does not by itself make the claimed structure obvious--there must be a motivation provided by the prior art, and that motivation is totally lacking in the reference.

The examiner finds the claimed shape would have been obvious urging that (our emphasis) "it is obvious for one skilled in the art to form each hook base of any desired shape \*\*\* since *this is within the capabilities of such a person.*" Thus, the examiner equates that which is within the capabilities of one skilled in the art with obviousness. Such is not the law. There is nothing in the statutes or the case law which makes "that which is within the capabilities of one skilled in the art" synonymous with obviousness.

The examiner provides no reason why, absent the instant disclosure, one of ordinary skill in the art would be motivated to change the shape of the coil hooks of Hancock or the German patent and we can conceive of no reason.

Ex parte Gerlach and Woerner, 212 USPQ 471 (PTO Bd. App. 1980)  
(emphasis in original).

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Therefore, it is submitted that the combination of the Bader reference with the Padilla and Sichau references would not lead one to the combination of features as claimed by the applicant.

Claims 3, 6, 7 and 9 are dependent upon claim 1, particularly as amended, and therefore incorporate the requirements of claim 1. Thus, claims 3, 6, 7 and 9 are also believed to be allowable over the cited reference.

Withdrawal of the §103(a) rejection of claims 3, 6, 7 and 9 is therefore respectfully requested.

#### Section 4 of the Office Action

Claim 12 has been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Bader (5,817,041) in view of Padilla (4,641,639) and in view of Lepage (5,605,535).

In regard to claim 1, it is submitted that the combination of Bader with Padilla and Lepage is not suggested by the prior art, and even if such a combination were to be made, one would not be led to the combination of features recited in applicants' claims. In particular, the references do not disclose, teach or suggest "each support member having an extension portion and a foot portion, said extension portion extending from said foot portion at an angle such that said extension portion is adapted for positioning in front of a lateral malleolus of the user, said foot portion of each of said support members being positioned in a spaced relationship and below the foot of the user to inhibit the foot of the user from contacting the supporting surface, said foot portion of each of said support members being positioned to a respective side of the foot without extending under the foot of the user to allow the foot portion of each of said support members to contact the support surface without said foot portion of said support members contacting the foot for inhibiting transfer of pressure into the foot of the user". As discussed above, the Bader and Padilla references teach away from each of the foot portions being positioned to respective

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sides of the foot while not extending under the foot to inhibit transfer of force to the foot of the user when the foot portions contact the supporting surface as claimed by the applicant. The Lepage reference teaches an ankle positioning splint that fails to teach each of the foot portions being positioned to respective sides of the foot while not extending under the foot to inhibit transfer of force to the foot of the user when the foot portions contact the supporting surface as claimed by the applicant. Further, the Lepage reference teaches away from that claimed by the applicant in that the Lepage reference teaches a foot base that contacts the bottom of the foot and the support surface and therefore allowing a portion of the force to be transferred to the foot of the user when the user is standing or walking. It is also submitted that the mere fact that one may argue that the prior art is capable of being modified to achieve a claimed structure does not by itself make the claimed structure obvious--there must be a motivation provided by the prior art, and that motivation is totally lacking in the reference.

The examiner finds the claimed shape would have been obvious urging that (our emphasis) "it is obvious for one skilled in the art to form each hook base of any desired shape \*\*\* since *this is within the capabilities of such a person*." Thus, the examiner equates that which is within the capabilities of one skilled in the art with obviousness. Such is not the law. There is nothing in the statutes or the case law which makes "that which is within the capabilities of one skilled in the art" synonymous with obviousness.

The examiner provides no reason why, absent the instant disclosure, one of ordinary skill in the art would be motivated to change the shape of the coil hooks of Hancock or the German patent and we can conceive of no reason.

Ex parte Gerlach and Woerner, 212 USPQ 471 (PTO Bd. App. 1980)

(emphasis in original).

Therefore, it is submitted that the combination of the Bader reference with the Padilla and Lepage references would not lead one to the combination of features as claimed by the applicant.

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Claim 12 is dependent upon claim 1, particularly as amended, and therefore incorporates the requirements of claim 1. Thus, claim 12 is also believed to be allowable over the cited reference.

Withdrawal of the §103(a) rejection of claim 12 is therefore respectfully requested.

#### Section 5 of the Office Action

Claim 13 has been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Bader (5,817,041) in view of Padilla (4,641,639) in view of Sichau (3,805,773) and in view of Lepage (5,605,535).

In regard to claim 13, it is submitted that the combination of Bader with Padilla, Sichau and Lepage is not suggested by the prior art, and even if such a combination were to be made, one would not be led to the combination of features recited in applicants' claims. In particular, the references do not disclose, teach or suggest "each support member having an extension portion and a foot portion, said extension portion extending from said foot portion at an angle such that said extension portion is adapted for positioning in front of a lateral malleolus of the user, said foot portion of each of said support members being positioned in a spaced relationship and below the foot of the user to inhibit the foot of the user from contacting the supporting surface, said foot portion of each of said support members being positioned to a respective side of the foot without extending under the foot of the user to allow the foot portion of each of said support members to contact the support surface without said foot portion of said support members contacting the foot for inhibiting transfer of pressure into the foot of the user". As discussed above, the Bader, Padilla, Sichau and Lepage references teach away from each of the foot portions being positioned to respective sides of the foot while not extending under the foot to inhibit transfer of force to the foot of the user when the foot portions contact the supporting surface as claimed by the applicant. Therefore, it is submitted that the combination of the Bader reference with the Padilla,

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Sichau and Lepage references would not lead one to the combination of features as claimed by the applicant.

It is further submitted that the need to combine a multiplicity of references in an attempt to meet the claimed invention is evidence of nonobviousness.

In this particular instance four references are combined. As discussed more fully above, the references must suggest the proposed combination in order to establish obviousness. Not only do none of the references suggest combination with any other single reference, there is absolutely no suggestion by any reference that as many as two other references should be combined with the potential primary reference.

Withdrawal of the §103(a) rejection of claim 13 is therefore respectfully requested.


### CONCLUSION

In light of the foregoing amendments and remarks, early reconsideration and allowance of this application are most courteously solicited.

Respectfully submitted,

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By

  
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